

REMARKS

Pursuant to previous amendments, the pending claims are 16 and 18-21. The Office as objected to claim 21 because of informalities. Claim 21 has been amended as set forth above to correct the cited informality. The Office has rejected the claims as follows: 18, 19 and 21 are rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement; claim 16 is rejected under 35 USC 103(a) over Shkedy in view of Sullivan et al.; claims 18-21 are rejected under 35 USC 103(a) over Shkedy in view of Sullivan et al. and further in view of Hoffman.

For the following reasons, the undersigned representative respectfully traverses the rejections as set forth below.

Rejection in view of 112, first paragraph

The Office has rejected claims 18, 19 and 21 under 35 USC 112, first paragraph, as failing to meeting the written description requirement. More particularly, the Office states specifically that the following limitation was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claims invention:

"when the buyer determines that the good is non-conforming, setting a third time period within which the buyer either (iii) returns the good to the seller or (iv) requests a bargaining session with the seller" (Claim 18);

"setting a third time period within which the buyer either (iii) returns the good to the seller or (iv) requests a bargaining session with the seller when the buyer determines that the good is non-conforming" (Claims 19 and 21).

The Office further rejects claim 18, citing lack of written description support for the following limitations as well: "when the seller determines that the good is in the same condition, retrieving the final bid amount from the escrow account; and returning the final bid amount to the buyer's payment account."

The undersigned notes that these limitations were in claims 18, 19 and 21 as originally filed and thus adequate written description is provided. See MPEP section 2163(I)(A) "Original Claims" (There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ("we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims")). Referring to MPEP section 2163(II)(A), "rejection of an original claim for lack of written description should be rare." Note also, "The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985)." MPEP Sec. 2163.03(III).

Accordingly, the undersigned respectfully requests that these rejections be withdrawn.

Rejection of Claim 16 Over Shkedy in View of Sullivan et al.

With respect to claims 16 and 18-21, each claim includes, *inter alia*, specific limitations for facilitating settlement between the buyer and the seller. Shkedy fails to teach or

suggest the combinations of limitations recited in claims 16 and 18-21. More particularly, for example, independent claim 16 includes:

....setting a first time period within which the seller must deliver the good to the buyer;

when the seller delivers the good to the buyer within the first time period, setting a second time period within which the buyer inspects the goods to determine conformance; and

when either (i) the buyer acknowledges conformance of the good within the second time period or (ii) the second time period expires with no further contact from the buyer, retrieving the final bid amount from the escrow account; and

crediting the final bid amount to the seller's payment account.

The undersigned has reviewed the Office's rejection and the Shkedy reference, but fails to see where these limitations are recited therein. At most, Shkedy teaches delay of payment until purchased goods are sent and confirmed received by the buyer. There is no discussion in Shkedy of the setting of particular time periods for the sending and inspection of goods. By setting specific time periods for facilitating the settlement process, the settlement process becomes transparent to the parties and allows for reliance on the time periods. This is not the case in Shkedy as no time periods are set. For example, referring to col. 20, lines 10-21 cited by the Office, how long must the buyer wait for the goods to be delivered by the seller? Indefinitely? Further, referring to col. 18, lines 8-15 as cited by the Office, how long must the seller wait before the seller is sure that the goods meet the buyer's conditions and will not be contacting an arbiter for dispute resolution? Because there is no set time period, what if the buyer comes back after payment has been completed? Shkedy does not offer any certainty to the parties as there are no specific time periods set.

Referring to Sullivan, Sullivan does not cure the deficiencies of Shkedy. In fact, Shkedy is not analogous art. As discussed in MPEP Sec. 2141.01(a), "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Sullivan is directed to a system and method for administering promotions. The words auction, bid, bargain and the like are not even found in the description of Sullivan and would not be expected to be found as Sullivan is not directed to an auction. Sullivan facilitates the administering of promotions based upon pre-established promotional criteria, i.e., if retailer sells 1000 of product X, manufacturer rebates Y amount. One skilled in the art of auction networks would not turn to references in the area of promotion administration to solve problems. Even assuming, *arguendo*, that Sullivan is analogous art, Sullivan does not teach or disclose setting the time periods described in claim 16.

The undersigned respectfully submits that claim 16 is allowable over the cited references.

Rejection of Claim 18-21 Over Shkedy in View of Sullivan et al. and Further in View of Hoffman

With respect to claims 18-21, each claim includes, *inter alia*, specific limitations for facilitating settlement between the buyer and the seller. As stated above with respect to claim 16, Shkedy fails to teach or suggest the combinations of limitations recited in claims 18-21. In addition to those limitations recited with respect to claim 16, claims 18-21 include additional time periods and actions for facilitating settlement, e.g., "setting a

third time period within which the buyer either (iii) returns the good to the seller or (iv) requests a bargaining session with the seller when the buyer determines that the good is non-conforming," also not taught or suggested by Shkedy. Finally, claims 20 and 21 specifically claim, *inter alia*, the process for facilitating settlement when a buyer bid is below the threshold value requested by the seller. Again, Shkedy does not teach or suggest this process.

Again, as stated above, Sullivan is not analogous art, and thus cannot cure the deficiencies of Shkedy.

Finally, the Office cites Hoffman (Pub. No. 20010039529) to cure the deficiencies of Shkedy and Sullivan. Hoffman does not qualify as prior art as it was filed on January 5, 2001, some 6 months AFTER the filing date of the present application and was published November 8, 2001, some 16 months AFTER the filing date of the present application.

The undersigned respectfully submits that claims 18-21 are allowable over the cited references.

CONCLUSION

The undersigned representative respectfully submits that the claims presented herein are in condition for allowance in view of the cited prior art and earnestly request a notice of allowance to that effect. Should there be any further issues regarding prosecution of this case, please do not hesitate to contact the undersigned at the number provided below.

Respectfully submitted,

Date: 3/21/05

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